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Pascal Arnaud

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11/12/2009

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1611

NOTIFICATION DATE

DELIVERY MODE

11/12/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/941,869	<b>Applicant(s)</b> ARNAUD, PASCAL	
	<b>Examiner</b> GINA C. YU	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-42, 44-51, 53-58, 60-78, 81-95, 101, 102, 105, 106 and 109-112 is/are pending in the application.
- 4a) Of the above claim(s) 53-57, 60, 61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-42, 44-51, 53-58, 60-78, 81-95, 101, 102, 105, 106 and 109-112 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

Receipt is acknowledged of amendment filed on July 1, 2009. The claim rejections as indicated in the previous Office action dated April 1, 2009 are maintained for reasons of record.

The claim rejection statements inadvertently included claim 103, a canceled claim, and the error has been corrected in this Office action.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 5-10, 31-35, 37-42, 44-51, 58, 62, 63, 65-70, 81-83, 85-95, 101-102, 105-106, 109-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul (US 5738841) in view of Nojima (EP 0548694 A1).**

The independent claims, claims 62 and 101, are directed to a transfer-resistant composition comprising (a) at least one non-volatile hydrocarbon-based oil with a molecular mass ranging from 230 to 420 g/Mol; (b) a silicone component consisting of one or more enlisted non-volatile silicone compound(s) in the claim; (c) from about 0.1-30 % by weight of the composition of an inert particulate phase; and (d) from 0 to about 5 % by weight of the total weight of the composition of a volatile oil, wherein the composition does not contain a silicone compound which is alkoxyated.

Mellul teaches a cosmetic lipstick composition comprising 60 % octyldodecyl neopentanoate (non-volatile hydrocarbon oil, MW 382.67), 0.1 % diphenyldimethicone (non alkoxyated non-volatile silicone oil), 5% alkyldimethicone (non-alkoxyated non-

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volatile silicone), and 12 % pigments. See examples 5 and 6; instant claims 5-10, 62-69, 91-95, 101, 102, 107. The reference teaches using octyldodecyl neopentanoate in 0.5-99 % by weight. See col. 2, lines 30 – 33; instant claims 32-35, 82. The reference teaches octyldodecyl neopentanoate is “an excellent agent for compatibilizing silicone-containing compounds with each other, has good thermal and chemical stability, and makes it possible to obtain compositions with much oilier texture on application than comparison with compositions of the prior art not containing it”. See col. 2, lines 11 – 21. The reference further teaches the ester has dispersant properties with respect to powders, and makes it possible to make a homogeneous dispersion. See col. 2, lines 21 – 24. The reference also teaches using at least one silicone-containing compound such as polymethylsiloxanes, alkyldimethicone, polyphenylmethylsiloxane, more specifically, phenyldimethicone and phenyltrimethicone; and silicones modified with aliphatic and/or aromatic groups, which optionally contain fluorine, or with functional groups such as hydroxyl, thiol and/or amine groups. See col. 2, lines 47- col. 3, line 5; see Example 3. See instant claims 105, 107, 109, and 110. Mellul further teaches the compositions can be formulated into various products including compacted powder (foundation, blusher or eyeshadow) or anhydrous products (lipstick, mascara). See col. 4, lines 11-16; instant claims 50, 51, 93, and 94.

Regarding claims 41-45, 87-90, Mellul teaches the compositions can contain a pulverulent phase comprising pigments and/or fillers (inert particulates). Possible pigments and fillers suitable for the make up compositions are taught, with some, for example, titanium dioxide coated mica and pearlescent, are named as either pigments

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or fillers. See col. 3, lines 30-45. The disclosed lipstick formulations of Examples 5 and 6 contain 11.9 % and 12 % of pigments, respectively, and do not specifically indicate the amount of fillers. Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” See In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In this case, based on the disclosure that a pulverulent phase can contain pigments and/or fillers, and lipstick formulations comprising specific amounts of pigments, the amount of fillers does not appear to be critical. It is viewed obvious for a skilled artisan to have discovered optimal amount of fillers of similar compositions within the disclosed range of pigments by routine experimentations.

Although Mellul mentions disadvantages of volatile hydrocarbon oils in col. 1, lines 22-28, the reference teaches using cyclomethicones D4, D5, and D6, which are volatile.

Nojima teaches volatile oils reduce the glossiness and stability of makeup products, particularly lipsticks, over time. See Nojima, p. 2, lines 13-18. Nojima teaches long-lasting, oil-based solid cosmetic compositions comprising one or more polyoxyalkylene modified silicones and one or more cosmetically acceptable oils, pigments and fillers. See abstract; Tables. See p. 4, lines 45 – 47 and lines 52 – 54 for the types of fillers and the amount used.

Since Nojima teaches a specific motivation to refrain from adding volatile oils in lipstick formulations, it is obvious that a skilled artisan would have been motivated to select the non-volatile silicone oils over volatile oils. See instant claims 105, 107, and 109-112.

Regarding the exclusionary proviso of alkoxyated silicone compounds of instant claims 62 and 101, Nojima does not teach away from the presently claimed invention because 1) the reference is cited to show the motivation to avoid volatile oils from formulating lipsticks; and 2) combining the teachings of Mellul and Nojima as proposed here does not necessarily require adding the alkoxyated silicone of Nojima. Since Mellul already discloses formulations without alkoxyated silicone or volatile oils, the skilled artisan would have had a reasonable expectation of successfully producing stable lipsticks that are similar to Mellul which does not lose glossiness over time.

**Claims 2-4, 11-19, 21-27, 36, 64, 71, 72, 74-78, and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul and Nojima as applied to claims 5-10, 31-35, 37-42, 44-51, 58, 62, 63, 65-70, 81-83, 85-95, 101-102, 105-107, 109-112 above, and further in view of Jacks et al. (US 5690918).**

Mellul and Nojima fail to teach non-volatile hydrocarbon oil having the MW limitation of instant claims 2-4 and the dispersant of the instant claims 11-19, 21-23, 36, 71, 72, 74-79, 84.

Jacks teaches that it is well known in cosmetic art that isononyl isononanoate (non volatile hydrocarbon oil, MW 284.48 g/mole) is used to make lipstick compositions. See Example 2; instant claims 2-4. The reference also teaches using 10.34 % of

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diisoarachidyl dilinoleate (dispersant) in the lipstick formulation. See Example 2. See instant claims 11-19, 21-23, 36, 71, 72, 74-79, 84.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the lipstick composition of the combined references by substituting octyldodecyl neopentanoate and a diisoarachidyl dilinoleate with isononyl isononanoate as motivated by Jacks because the references are directed to lipstick formulations and Nojima and Jacks teach that these hydrocarbon oils are well known functional equivalents in lipstick art. The skilled artisan would have had a reasonable expectation of successfully producing a stable lipstick composition with similar effectiveness.

**Claims 20 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nojima and Mellul as applied to claims 5-10, 31-35, 37-42, 44-51, 58, 62, 63, 65-70, 81-83, 85-95, 101-102, 105-107, 109-112 as above, and further in view of JP 63119412.**

Mellul and Nojima, discussed above, do not teach poly(hydroxyl-12) stearic acid.

JP 63119412 abstract teaches 12-hydroxystearic acids is well known in lipstick art, and that the compositions having 12-hydroxystearic acid along with polyhydric alcohol esters of rosin, fatty acids with polyhydric alcohol gives improved luster and good dispersion of color. See abstract.

It is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining

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them flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980). As shown by the recited teachings, the instant claims define nothing more than the concomitant use of conventional lipstick agents. It would follow that the recited claims define prima facie obvious subject matter.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have added 12-hydroxystearic acid as motivated by JP 63119412 because of the expectation of successfully producing a lipstick composition with improved luster and good dispersion of color, as taught by the Japanese abstract.

### ***Response to Arguments***

Applicant's arguments filed on July 1, 2009 have been fully considered but they are not persuasive.

Applicant asserts the rejection made over Mellul in view of Nojima had been overcome by applicant's previous arguments. Applicant argues, the rejection "merely sets forth a distinction without a difference, and is not persuasive". Examiner respectfully points out that the withdrawal of an obviousness rejection does not preclude citing the same references previously used for finding different motivation to make the present invention. Furthermore, in the February 2008 Office action, the previous rejection was made over Nojima in view of Mellul, with the Nojima patent as the primary reference. In the contrary, the present rejection is made over Mellul in view of Nojima, wherein the Nojima reference is cited to show the motivation to exclude



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volatile oils from the Mellul invention. The rejections are not the same, and the previous Office action did not "unfairly" prolong the prosecution, as applicant stated in the remarks, but was necessarily to address patentability of the present invention.

Applicant appears to assert that, in order to exclude volatile oils from the Mellul invention, Nojima's alkoxyated silicones must be incorporated to the composition to compensate the absence of a volatile oil. Modifying the Mellul composition in such way is unnecessary because the closest prior art already exemplifies a lipstick composition that does not contain neither of volatile oils or alkoxyated silicone oils which applicant has excluded from the present invention. As discussed in the rejection, Example 5 shows a lipstick comprising 60 % octyldodecyl neopentanoate (non-volatile hydrocarbon oil, MW 382.67), 0.1 % diphenyldimethicone (non alkoxyated non-volatile silicone oil), 5% alkyldimethicone (non-alkoxyated non-volatile silicone), and 12 % pigments. Alkoxyated silicone is not a necessary component in modifying the Mellul invention to make the present composition because the prior art already has been formulated with other non-volatile silicone oils. Nojima is only cited to show choosing non-volatile silicones over volatile silicone oils, such as cyclomethicone, would have been obvious to a skilled artisan.

Applicant's description of the Mellul invention as "surprisingly" homogeneous compositions containing non-alkoxyated silicones on p. 19 of the remarks is not well understood. Mellul does not concern using or excluding alkoxyated silicones. The prior art already has successfully produced a stable composition without dry feel by using non-volatile hydrocarbon and silicones oils that are used in the present invention. Thus,

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no novelty or nonobviousness is seen in modifying the Mellul's example formulation to make the present invention by adding fillers in an optimum amount. Nor has applicant shown any unexpected or nonobvious result of the present composition by excluding alkoxyated silicone. In fact, applicant's specification even teaches that alkoxyated silicone is merely an art-recognized functional equivalent to the non-volatile silicones disclosed in Mellul. See specification, p. 11, bridging paragraph.

Applicant also argues that one skilled in the art would not modify Jacks because the prior art requires a substantial amount of volatile oil to make a film-forming composition. However, the grounds of the present obviousness rejection are that the Mellul, not Jacks, lipstick is modified in view of the secondary references. Applicant's argument that isononyl isononanoate from Jacks invention should be used only in the presence of volatile oils is unpersuasive.

For the above reasons, applicant's arguments are viewed unpersuasive, and the obviousness rejections of April 1, 2009 Office action are maintained for reasons of record.

### ***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605. The examiner can normally be reached on Monday through Thursday, from 8:00AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/GINA C. YU/  
Primary Examiner, Art Unit 1611